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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,133	09/25/2001	William Stevens Taber JR.	20162-000310US	1723

20350 7590 03/10/2005

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/964,133

Applicant(s)

TABER, WILLIAM STEVENS

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilugin: "No Wasted Energy" (Publication) in view of Yablonowski et al. (US 6,535,859) (Yablonowski).**

Publication, which appears to be published in January 1985, discloses a method for conserving energy and a marketing plan that conserves capital, comprising:

**As per claim 1,**

procuring by an implementing entity (North Atlantic Technologies Inc.) a heat-exchanger system which allows to save energy from a supplier of said system (Page 2, 4<sup>th</sup> paragraph);

installing by said implementing entity said heat-exchanger system to an end user at no cost to said end user (Page 3, 4<sup>th</sup> paragraph), and

selling by said implementing entity said conserved energy to said end user at a rate 30 percent below that paid for the primary energy source (Page 3, 4<sup>th</sup> paragraph), wherein selling said conserved energy indicates measuring of said conserved energy.

Publication does not specifically teach auditing by said implementing entity of energy using equipment at multiple end user sites to identify equipment that is a candidate for replacement.

Yablonowski teaches a method for maintaining lighting systems and for monitoring energy consumption of the lighting systems, comprising:

auditing by implementing entity (said entity comprising an engineering firm, a contractor, a wholesale fixture company, and a lighting service company) energy saving

equipment at multiple end user sites to determine whether the end user's facilities fall within the guidelines of the program, and to determine the financial feasibility of the project (column 6, lines 24-30, 55-56);

providing and deploying by said implementing entity said energy efficient equipment at no cost to said end users (column 7, lines 9-11);

measuring by said implementing entity of said saved energy at said sites using a method of measurement agreed upon by said end users and said implementing agency (column 7, lines 25-26, 42-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication to include auditing by said implementing entity of energy using equipment at multiple end user sites, as disclosed in Yablonowski, because it would advantageously allowed to identify the most feasible projects thereby maximize profits.

**As per claim 2**, Yablonowski teaches said method, wherein said deployment at said multiple end user sites is performed in a coordinated manner (column 6, line 54 – column 7, line 41). The motivation to combine Publication with Yablonowski would be to avoid possible delays during implementation of the project, thereby minimize financial losses.

**As per claim 3-5**, see reasoning applied to claim 1.

**As per claim 6**, Publication in view of Yablonowski teaches all the limitations of claim 6, expect that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor.

Official notice is taken that it is old and well known that auditing is performed by an auditor specializing in his task rather than a person having general knowledge of the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Publication and Yablonowski to include that auditing is performed by an auditor specializing in evaluating the potential energy saving for a selected type of said energy saving equipment rather than a generalist energy auditor, because it would advantageously minimize possible mistakes in auditing, thereby minimizing potential financial losses.

**As per claims 7-9 and 12**, Yablonowski teaches said method, wherein actual cost, rather than estimated cost, of said energy saving equipment is utilized to project financial feasibility for said deployment by said implementing entity (column 6, lines 24 – column 7, line 26; column 7, lines 42-63). The motivation to combine Publication with Yablonowski would be to enhance accuracy of calculating feasibility of the project, thereby minimize financial losses.

**As per claim 10**, Yablonowski teach said method, further comprising methods to reduce financial risk to said implementing entity (column 6, lines 24-29, 54-56). The motivation to combine Publication with Yablonowski would be to minimize financial losses.

**As per claim 11**, Yablonowski teaches said method, wherein said procurement is performed in a volume sufficient to increase profit of said sale of saved energy to a preselected amount (column 6, lines 54-56). The motivation to combine Publication with Yablonowski would be to keep business profitable.

**As per claims 16-17**, Yablonowski teaches said method, wherein an energy utility company provides an incentive to undertake said procurement, said deployment and combinations thereof (column 1, lines 25-28).

**As per claims 18-21**, see reasoning applied to claim 1.

**Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Yablonowski and further in view of Adams et al. (US 6,154,730) (Adams).**

**As per claims 13 and 14**, Publication in view of Yablonowski teach all the limitations of claims 13 and 14, except that mode of financing is credit enhancement.

Adams teaches a method for facility-based financing, wherein credit financing is utilized (column 4, lines 9-12).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Publication and Yablonowski to include that mode of financing is credit enhancement, as disclosed in Adams, because it would advantageously simplify financing of the project.

**Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Yablonowski and further in view of King (US 6,148,293).**

**As per claim 15**, Publication in view of Yablonowski teach all the limitations of claim 15, except that mode of financing includes tax-exempt, floating rate.

King teaches a method and system for creating a financial instrument and administering an adjustable rate loan system, wherein tax-exempt, floating rate is employed (column 6, lines 11-40; column 17, lines 16-26).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Publication and Yablonowski to include that mode of financing includes tax-exempt, floating rate, as disclosed in King, because without indicating in the specification the advantage of said tax-exempt, floating rate, financial instrument it appears that use of said tax-exempt, floating rate mode of financing is an obvious variation of any financing mechanism.

**Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Yablonowski and further in view of Wallman (US 6,360,210).**

**As per claim 22**, Publication in view of Yablonowski teach all the limitations of claim 22, except that risk of inadequate energy saving equipment performance is undertaken by a party other than said implementing entity or said end user.

Wallman teaches a method and system for enabling smaller investors to manage risk in a self-managed portfolio of assets, wherein a risk for a given project (portfolio) can be transferred to a third party (column 5, line 64 – column 6, line 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication and Yablonowski to include that risk of inadequate energy saving equipment performance is undertaken by a third party, as disclosed in Wallman, because it would advantageously stimulate end users to replace the old equipment with more energy efficient equipment.

**Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Yablonowski and further in view of Johnson (US 6,169,979).**

As per claim 23, Publication in view of Yablonowski teach all the limitations of claim 23, except using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment.

Johnson teaches a computer-assisted method and system for utilities, wherein environmental rebates are employed (column 5, lines 1-21).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication and Yablonowski to include using environmental rebates to stimulate end users to replace the old equipment with more energy efficient equipment, as disclosed in Johnson, because it would advantageously provide the financial incentives for the end users to reduce pollution and contamination of the environment.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571) 272-6801 after that date.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist before April 13, 2005, whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702 before April 13, 2005, and (571) 272-6812 after that date.

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Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***


***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Igor Borissov  
Patent Examiner  
Art Unit 3629

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, sweeping flourish at the end.

IB

03/05/2005